

Application No. 10/629,242

Reply to Office Action

REMARKS*Summary of the Office Action*

The Office Action of August 8, 2005, advises that claims 1-20 are subject to a restriction requirement. Specifically, claims 1-5 and 11-20 are said to constitute Group I (a nano-porous metal oxide semiconductor and photovoltaic device), while claims 6-10 are said to constitute Group II (a method of making the nano-porous metal oxide semiconductor). The Action advises that, because of the purported divergent claimed subject matter set forth in Groups I and II, a search must be undertaken in different classes.

Discussion

Applicants respectfully traverse the restriction requirement. There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (M.P.E.P. § 803).

In this case, the Action fails to meet the required criteria. The Action has not alleged that there would be a serious burden on the Examiner absent the restriction requirement. Although the inventions of Groups I and II may be patentably distinct, applicants submit that the Examiner would not be unduly burdened in his search for prior art relevant to each group due to the overlapping nature of the subject matter claimed therein. For these reasons, withdrawal of the restriction requirement is respectfully requested.

If the restriction is made final, however, applicants provisionally elect the claims of Group I (1-5 and 11-20) for prosecution at this time.

Should there be any questions regarding this response, the Examiner is invited to contact the undersigned attorney at his convenience.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,



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